UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,071	03/31/2004	Stephen R. Lawrence	24207-10075	7847

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EXAMINER
NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/815,071	LAWRENCE ET AL.
	Examiner	Art Unit
	Merilyn P. Nguyen	2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-55</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-55</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>31 March 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>10/07/2004</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☒ Other: <u>Detailed Action</u>.

DETAILED ACTION

1.   Claims 1-55 are pending in this action.

2.   PCT US0510687 is a continuation of this present application.

Acknowledges

3.   Receipt is acknowledged of the following items:

   o Information Disclosure Statement (IDS) filed on 10/07/2004 and made of record

      as Paper No. 2. The references cited on the PTOL 1449 form have been

      considered.

Specification

4.   The disclosure is objected to because of the following informalities: status of copending

application must be updated at page 1, line 13 of the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112: .

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1, 28 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding claims 1, 28 and 55, the claims are being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the limitation of "indexing the event" does not related to the other limitations in the claim. It's unclear how the index is used in order to product useful and practical application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 1, 5-15, 18-20, 22-28, 32-42, 45-47, and 49-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96),' In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQZd 1600, 1603-06 (Fed. Cir. 199334. Accordingly, a complete disclosure should contain some

indication of the <u>practical application</u> for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQZd at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file <u>stored on a disk</u> may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some <u>"real world"</u> value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Maher Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

> The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result.

Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no

substantial practical application").

Claimed invention (Claims 1, 5-15, 18-20, 22-28, 32-42, 45-47, and 49-54) recites a

method comprising capturing an event associated with an article, wherein the event comprises

event data; indexing the event; creating a related event object related to the event, wherein the

related event object comprises a set of one or more related events; and associating the related

event object and the one or more related events which do not provide useful and tangible results

as to whether their execution accomplishes a practical application. For example, the limitation of

"indexing the event" does not related to other limitations of the claim. It's unclear how

limitations of the claim are cooperated to product useful and practical application. Moreover, for

it to be a tangible result, it must be more than just a thought or a computation. Instead, it must

have real world value rather than being an abstract result. A tangible result is not attained after

associating the related event object and the one or more related objects. All other claims are

rejected under 101 for failing to solve the deficiencies of claim 1 from which it depends.

Claimed invention (Claims 28-54) recites a computer-readable medium that is defined in

the Applicant's specification broader to read media that may transmit or carry instructions to a

computer, including a router, private or public network, or other transmission device or channel,

both wired and wireless. (Page 5, paragraph [0014]). A medium transmitting or carrying

instructions is not a process, machine, manufacture, nor composition of matter, thus is a non

statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-8, 11-14, 16-22, 28-35, 38-41, 43-49 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Vleet (US 2005/0033803).

Regarding claims 1 and 28, Vleet discloses a method and a computer-readable medium containing program code, comprising: capturing an event associated with an article (See page 2, paragraph [0023], lines 4-9, and [0025]), wherein the event comprises event data (See page 2, paragraph [0023], lines 4-9); indexing the event (See pages 2-3, paragraph [0026], lines begin at page 3); creating a related event object related to the event (See page 2, paragraph [0026], lines 1-17]), wherein the related event object comprises a set of one or more related events and paragraph [0027], "URL accesses"); and associating the related event object and the one or more related events (See paragraph [0027]).

Regarding claims 2 and 29, Vleet further discloses storing the related event object and storing at least a portion of the event data (See page 2, paragraph [0026]).

Regarding claims 3 and 30, Vleet discloses wherein the related event object is stored at a first location within a data store (See page 2, paragraph [0026] and paragraphs [0035], [0037]).

Regarding claims 4 and 31, Vleet discloses wherein at least a portion of the event data is stored at a second location within the data store (See page 2, paragraph [0026] and paragraphs [0035], [0037]).

Regarding claims 5 and 32, Vleet discloses wherein the event is captured in real-time and indexing the event occurs close in time to capturing the event (See pages 2-3, paragraph [0026], lines begin at page 3 and paragraph [0042]).

Regarding claims 6 and 33, Vleet discloses wherein the event is a historical event and indexing the event is delayed in time after occurrence of the event (See page 2 paragraph [0026]).

Regarding claims 7 and 34, Vleet discloses wherein the article is associated with a client application (See page 2, paragraph [0023]) and the related event object comprises a list of different events associated with the article (See pages 2-3, paragraph [0025] and [0027]).

Regarding claims 8 and 35, Vleet discloses wherein the article comprises a web page and the related event object comprises a list of events comprising accesses to a URL for the web page (See page 3, paragraph [0027]).

Regarding claims 11 and 38, Vleet discloses wherein the article comprises a word processing document and the related event object comprises a list of events comprising at least

some of load, save and print events associated with the word processing file (See paragraph [0045]).

Regarding claims 12 and 39, Vleet further discloses creating a second level related event object comprising a set of one or more related event objects; and providing a pointer between the second level related event object and the one or more related events objects (See page 3, paragraph [0028], "event objects for the last fifty search queries submitted by a particular user").

Regarding claims 13 and 40, Vleet discloses wherein the article is associated with a client application (See page 2, paragraph [0023]) and the related event object comprises a list of different events associated with the article (See pages 2-3, paragraph [0025] and [0027]), and the second level related event object comprises a list of related event objects comprising articles associated with the client application associated with a specific directory (See page 4, paragraph [0044] and [0046]).

Regarding claims 14 and 41, Vleet discloses wherein the article comprises a web page and the related event object comprises accesses to a URL for the web page associated with a website, and the second level related event object comprises a list of related events objects comprising accesses to URLs associated with the website (See page 3, paragraph [0027]).

Regarding claims 16 and 43, Vleet discloses wherein the first location within the data store comprises a database (See Fig. 2 and paragraph [0053]).

Regarding claims 17 and 44, Vleet discloses wherein the second location within the data

store comprises a repository (See Fig. 2 and paragraph [0053]).

Regarding claims 18 and 45, Vleet discloses after creating the related event object:

capturing at least one second event associated with the article; indexing the second event;

determining that the second event relates to the related event object; creating a pointer between

the second event and related event object; and updating the related event object to record the

second event. Please see paragraphs [0026-0027].

Regarding claims 19 and 46, Vleet discloses wherein the at least one second event

comprises a plurality of second events, the method further comprising: serially repeating the

steps of capturing, indexing, determining, creating and updating for each additional second

event. Please see paragraphs [0026-0027].

Regarding claims 20 and 47, Vleet discloses receiving a search query; retrieving events

relevant to the search query; retrieving related event objects having related event object data for

the relevant events; and ranking the relevant events based at least in part on the event data and

the related event object data.

Regarding claims 21 and 48, Vleet discloses receiving a search query (See reference 110,

Fig. 4 and corresponding text); retrieving events relevant to the search query (See page 3,

paragraph [0028] and page 6, paragraphs [0062-0063]); retrieving related event objects having related event object data for the relevant events (See page 3, paragraph [0028] and page 6, paragraphs [0062-0063]); and outputting the relevant events based at least in part on the event data and the related event object data (See page 3, paragraph [0028]).

Regarding claims 22 and 49, Vleet discloses receiving updated event data for the event and associating the updated event data with the event (See page 2, paragraph [0025]).

Regarding claim 55, Vleet discloses all the subject matter as addressed above, thus rejected at the same ground.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 9-10, 15, 36-37 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vleet (US 2005/0033803), in view of Belfiore (US 2002/0059425).

Regarding claims 9 and 36, Vleet discloses all the claimed subject matter as set forth above. However, Vleet is silent as to wherein the article comprises an email message and the related event object comprises a list of events comprising email messages in an email thread.

Belfiore teaches the article comprises an email message and the related event object comprises a

list of events comprising email messages in an email thread (See page 13, paragraph [0142],

[0146-0147] and [0267], Belfiore et al. The Examiner notes that these limitations are not

functionally involved in the steps or elements of the recited. Therefore these limitations are

deemed to be nonfunctional descriptive material. The steps of method would be performed the

same regardless of what type of articles. Thus this nonfunctional descriptive material will not

distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack,

703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32

USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. .). Therefore, it would have been obvious

to one having ordinary skill in the art at the time of the invention was made to place email

message as one of articles and list of events comprising email messages because such type of

article does not functionally relate to the elements of the claimed system and because the

subjective interpretation of different types of articles does not patentably distinguish the claimed

invention.

Regarding claims 10 and 37, Vleet/Belfiore discloses wherein the article comprises an

instant messenger message and the related event object comprises a list of events comprising

instant messenger messages in a conversation (See page 2, paragraph [0020], Belfiore et al.) and

as analyzing similar as addressed above in claim 9.

Regarding claims 15 and 42, Vleet/Belfiore discloses wherein the article comprises an

instant messenger message and the related event object comprises a list of events comprising

instant messenger messages in a conversation, and the second level related events object

comprises a list of related event objects comprising instant message conversations associated

with a particular user as addressed above in claims 9 and 10.

9.   Claims 23-25 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Vleet (US 2005/0033803), in view of Hrabik (US 2002/0178383).

Regarding claims 23 and 50, Vleet discloses all the claimed subject matter as set forth

above. However, Vleet is silent as to a fingerprint of the event data is computed. On the other

hand, Hrabik teaches a fingerprint of the event is computed (See 514, "database of event

"fingerprints" and paragraph [0056], Hrabik et al.). It would have been obvious to one having

ordinary skill in the art at the time of the invention was made to create a fingerprint for the event

data. The motivation would have been to consolidate security of event based on analyzing the

event data collected by the collection engine (See paragraph [0056], Hrabik et al.).

Regarding claims 24 and 51, Vleet/Hrabik discloses wherein the fingerprint is computed

by analyzing text associated with the event (See [0056], Hrabik et al.).

Regarding claims 25 and 52, Vleet/Hrabik discloses wherein the fingerprint is computed

by analyzing a location and time associated with the event (See [0056], Hrabik et al.).

10.   Claims 26-27 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Vleet (US 2005/0033803), in view of Hrabik (US 2002/0178383), and further in view of

Maxham (US 2004/0187075).

Regarding claims 26 and 53, Vleet/Hrabik discloses all the claimed subject matter as set

forth above. However, Vleet/Hrabik is silent as to wherein the fingerprint is used to determine if

the event is a duplicate event that has already been indexed. Maxham, on the other hand, teaches

comparing the fingerprints of documents to find the duplicate documents (See page 3, paragraph

[0036], Maxham et al.). Although Maxham system uses fingerprint to determine duplicate

document, it would have been obvious to one having ordinary skill in the art at the time of the

invention was made to apply Maxham fingerprint feature on detecting duplicate event of

Vleet/Hrabik system because the event itself broadly considered as file or document. The

motivation would have been to eliminate duplicate events so that processing event faster and less

time comsumed.

Regarding claims 27 and 54, Vleet/Hrabik/Maxham discloses the event is not indexed if

the event is determined to be a duplicate event and access statistics associated with the related

event object are updated as Maxham teaches duplicate document is discarded from uploading

(See paragraph [0036], Maxham et al.).

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Pugh U.S Patent No. 6,658,423 discloses detecting duplicate and near-duplicate files.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.
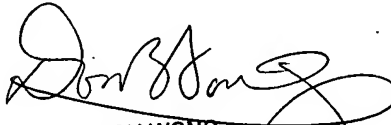
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
December 05, 2006

DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100